



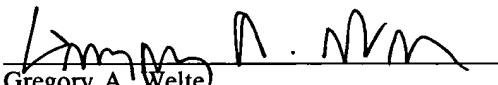
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 8594.00)
Group Art Unit: 2178)
Serial No.: 09/829,225)
Examiner: Cesar B. Paula)
Filing Date: April 9, 2001)
Title: Improved Operation of)
Web Sites on Internet)
)
)

REPLY TO EXAMINER'S ANSWER

CERTIFICATE OF MAILING

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Gregory A. Welte

OVERVIEW OF REPLY

Claim 3

Claim 3 depends from claim 1.

Parent claim 1(b) recites performing certain "background research." The Answer finds this "background research" in a process in a Javascript reference, wherein a "cookie" is looked up. That cookie is a small document which is stored in a user's computer.

Dependent claim 3 states that the "background research comprises contacting another web site."

Appellant fails to see, and the PTO has not explained, how

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the "background research" of claim 1(b) can "comprise contacting another web site" as claim 3 states.

The rejection of claim 3 cannot stand.

Claim 1

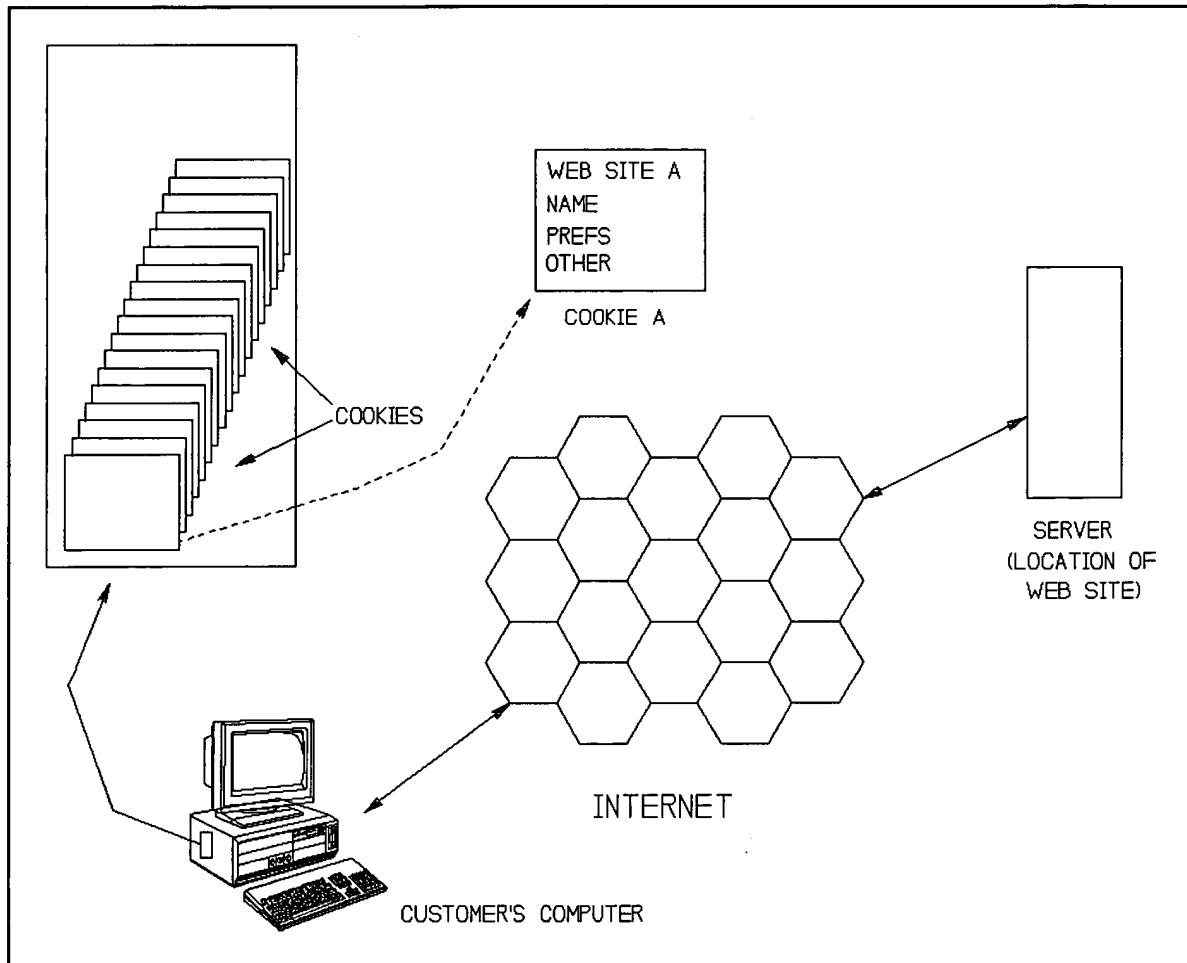
This Overview will explain the Javascript reference, and its application to claim 1.

Javascript

The rejection relies heavily on "cookies" described in the Javascript reference. Sketch 1, below, illustrates cookies.

A person (not shown), utilizing the CUSTOMER'S COMPUTER, visits a web site on the Internet. The web site is generated by the SERVER.

The web site may place a "cookie" into the CUSTOMER'S COMPUTER. The cookie is a small file, or document, and all cookies created by the web sites are stored in a single location within the CUSTOMER'S COMPUTER. Every cookie contains the name of the web site which created the cookie, and all cookies are listed according to those names, for later recovery.



SKETCH 1

For example, to recover a cookie, the SERVER may give an instruction to software located in the CUSTOMER'S COMPUTER to fetch the cookie bearing the name "WEB SITE A." COOKIE A, created by WEB SITE A, will be fetched in response.

The cookies allow the web sites to store information of

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interest to themselves in the CUSTOMER'S COMPUTER. For example, a web site may ask the customer his name, and store that name in the cookie. In Sketch 1, this NAME is illustrated in COOKIE A, which is created by WEB SITE A.

Later, when the CUSTOMER'S COMPUTER visits WEB SITE A again, software in the CUSTOMER'S COMPUTER looks for the cookie of WEB SITE A (COOKIE A). When the cookie is found, the NAME is retrieved from COOKIE A.

Other software can then incorporate that NAME into a message which is displayed on the screen of the CUSTOMER'S COMPUTER. Thus, the message can attempt to greet the person by name. Of course, if, at a later time, a different person uses the CUSTOMER'S COMPUTER to visit WEB SITE A, the message will contain the wrong name.

Appellant points out the following.

- 1) In general, numerous cookies are stored in the CUSTOMER'S COMPUTER, as indicated in Sketch 1. Software within the CUSTOMER'S COMPUTER searches for a cookie (if present) bearing the name of the web site being visited. This prevents other web sites from snooping through all the cookie files, in an attempt to steal information.

2) Conversely to Point 1, immediately above, no search is done directly for the NAME in the cookie. This should be self-evident because the person's NAME can be contained in many different cookies, belonging to many different web sites. Such a search would allow one web site to recover cookies belonging to other web sites. Hence, such a search is not done.

3) In continuing Point 2, Appellant points out that the Answer, page 13, in the TABLE, asserts that Javascript searches for the NAME in Sketch 1, and that this shows claim 1(b). However, that is not correct. One reason is that, when the "search" is begun, the name of the person visiting the web site is not known.

A second reason is that, if the name were known, the search for that name would be pointless.

A third reason is that the person's name is contained in multiple cookies, from multiple different web sites. The PTO has not explained how Javascript selects one of those cookies.

- 4) As a continuation to Point 3, Appellant points out that, as claim 1 is applied by the PTO, it is **impossible** to perform a search directly for the NAME. That NAME is not known to the web site when the person visits the second time, which is the situation existing when the PTO reads claim 1(b). This will be made clear later.
- 5) The COOKIE in Sketch 1 is specific to the CUSTOMER'S COMPUTER, not to the original person who supplied the name which was placed into the cookie. That is, if a different person, using the CUSTOMER'S COMPUTER, visits WEB SITE A later, WEB SITE A will locate COOKIE A, and read the NAME from COOKIE A. That NAME will not correspond to this different person. The reason is, again, that the cookie is specific to the CUSTOMER'S COMPUTER, because that is where the cookie is stored, and from which the cookie is retrieved.

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6) The Javascript reference explicitly states that the cookie-information is **NOT** transmitted to the WEB SITE in Sketch 1. The locating-and-retrieval of COOKIE A is done by software which is located on the CUSTOMER'S COMPUTER. So is the generation and display of the greeting-message discussed above. (See the second "Q" in the Q&A section of Javascript.)

This Point 6 is significant because, in rejecting some claims other than claim 1, the Answer argues that (1) the NAME in COOKIE A is sent to the WEB SITE and (2) the WEB SITE packages the NAME into a web page, which is transmitted to the CUSTOMER'S COMPUTER. That operation simply does not occur in Javascript.

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Application to Claim 1

Claim 1

Claim 1 recites:

1. A method of operating a web site, comprising:
 - a) identifying a first visitor to the web site;
 - b) performing first background research on the first visitor;
 - c) based on the background research, selecting first information from a collection of information; and
 - d) transmitting the first information to the first visitor.

Example of Claim 1

An example of subject matter supporting claim 1 is the following. A person visits a web site, and is identified as in claim 1(a). For example, a name could be retrieved from a cookie and displayed to the person, with the well-known associated message which states "If this is not your name, please identify yourself."

Then the web site performs background research on the person as in claim 1(b), as by examining a file of demographic information stored about the person. In this background research, the web site may learn that the person is a professional bicycle racer.

Then, as in claim 1(c), using the background research, the web site selects appropriate advertising ("first information") for the person. For example, if the web site sells bicycle equipment, the

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advertising may describe extremely lightweight, extremely strong, but extremely expensive bicycle equipment for the professional racer just identified.

Then, as in claim 1(d), the advertising is transmitted to the person.

Problems with the Rejection

A basic problem is that the Answer uses a **single event** in Javascript to show **both** claims 1(b) and (c). Further, even if it is proper to use the **single event** in this way, that **single event** does not actually show the recitations of claims 1(b) and (c). Also, the Answer uses a non-existent event in Javascript to show claim 1(b).

The TABLE on page 13 of the Answer shows how claim 1 was rejected.

NON-EXISTENT EVENT

The TABLE, second row, asserts that "Javascript search of user's name upon user's return to the website" shows claim 1(b).

However, as explained above, in Javascript, there is no **direct** search for the NAME in COOKIE A in Sketch A. Instead, a search is done for the cookie containing the name of the **web site** which is currently being visited. When **that web site's name** is found in a cookie, then a person's name can be read from that cookie.

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Thus, in Javascript, no search is done for the **person's name**. Instead, the search is done for the **web site's name**.

Further, it is **impossible** to search for the person's name. The Answer purports to find claim 1(b) in a **second visit** by a person to a web site. (See TABLE, Answer, page 13.) However, when the person arrives at the web site, that person's name is not known. That person is anonymous. Thus, it is impossible to search the cookies for the name of that person, because the name of that person is not known.

Instead, the name of the web site (which is, of course, known) is searched: the cookies are searched for the name of that web site.

It could be argued that this is a distinction-without-a-difference on the grounds that, in either case (search for web site name vs. search for person's name), the person's name (if present) is retrieved because of the search.

However, that argument misses the point.

The point is that the **actual search done** in Javascript (search for web site name) does not correspond to the claim language, which is

- b) performing first background research on the first visitor.

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Restated, the search in Javascript does not amount to "performing" the claimed "background research," for several reasons.

One reason is that, at the time the search is initiated, nothing at all is known about the "visitor." The web site only knows that a visitor, who is anonymous, has arrived.

-- The web site does not know that the visitor is using the CUSTOMER'S COMPUTER shown in Sketch 1.

-- The **web site** does not know the name of the visitor.

Thus, when the search-for-the-cookie is initiated, the identity of the visitor is not known.

Therefore, how can that cookie-search qualify as "b) performing first background research **on the first visitor** ? The identity of the visitor is not known. How can "background research" be performed on an anonymous person ?

A second reason will address a specific interpretation of the searching in Javascript. It could be argued that the Javascript system, in effect, says, "I will look up a cookie and learn something about this unknown visitor. That is 'background research' on that visitor."

However, one problem is that finding out the name of a

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visitor, and nothing more, hardly amounts to "background research." The "background" of a person refers generally to events occurring in a person's history, or to characteristics of the person, and not merely his name.

A second problem is that, even if learning a person's name qualifies as learning **part** of his background, that part is a **trivial** "background," in the context of the invention. Appellant points out that, for claim 1 to be anticipated by Javascript, Javascript must **infringe** claim 1. It is axiomatic that **trivial** infringement does not qualify as **actual** infringement. Restated, **literal** infringement, by itself, is insufficient, because it is considered trivial.

A third problem is that the person's name-in-the-cookie may not correspond to the current visitor. Thus, even if retrieval of that name amounts to "background research," it is "background" on the person who gave his name to the web site when the cookie was created. It is not necessarily "background" on the current visitor.

A fourth problem is that, even if learning the person's name does amount to the "background research," then another part of the claim, claim 1(c), is not present in Javascript. This absence will be explained, after an Interim Conclusion is given.

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INTERIM CONCLUSION

The Answer, in the TABLE on page 13, relies on "Javascript search of user's name" to show the "background research" of claim 1(b). However,

-- There is no direct "search of user's name" in Javascript. There is a search for a cookie containing a web site's name, and then retrieval of a person's name from that cookie. But the person's name is not searched directly. His name is not even known when the cookie-search begins.

-- When the cookie-search is initiated, the name of the person **is not known**. How do you perform "background research" without knowing the name of the person being researched ?

-- If the person's name were known, and a cookie were sought which contains that name, that would be pointless. And that does not amount to "background research," even very broadly defined. The person's name was known before the search began. What did the

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"research" uncover ?

-- If the person's name were known, and a cookie were sought which contains that name, multiple cookies would be found. The PTO has not explained what is done with those multiple cookies, and how that amounts to "background research."

-- As explained later, both Javascript and the Answer (at certain locations) assert that this cookie-look-up is identification, or attempted identification, of the visitor. The only reason the Answer calls this cookie-look-up "background research" is to attempt to show claim 1(b). But identification is not background research.

-- The only argument left is that searching for the web site's cookie may produce the name of an unknown visitor, and that amounts to "background research," in the sense that something is sought, or learned, about the unknown person.

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Appellant asserts such a search is **not** "background research," nor is it necessarily "background research" on the current visitor.

Further, even if that does amount to "background research," it is trivial, and does not show the required infringement. It shows nothing more than literal infringement, if that.

-- But even if the Answer is correct, and the cookie-look-up does show claim 1(b), then claim 1(c) is absent from Javascript, which will now be explained.

IF ASCERTAINING NAME FROM COOKIE IS "BACKGROUND RESEARCH"
OF CLAIM 1(b), THEN
CLAIM 1(c) IS ABSENT FROM JAVASCRIPT

The Answer's TABLE, page 13, third row, asserts that "Selecting the user's name from the cookie file" in Javascript shows claim 1(c), which is repeated here:

c) based on the background research, selecting first information from a collection of information.

Several problems are present in the Answer's assertion.

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One problem is that the Answer **already used** that name-retrieval-from-cookie to show claim 1(b). A **single** event in Javascript cannot be used to show **two** claim elements.

MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

A second problem is that claim 1(c) states that "selecting" the "information" (advertising, for example) is "**based on** the background research" of claim 1(b). (In the bicycle-racer example above, the background research indicated that the visitor was a professional bicycle racer. The selection of high-end advertising of bicycle components, the "information," was thus "based on" that "background research.")

Contrary to this, the Answer is asserting that Javascript's name-retrieval-from-cookie qualifies as the "information" "selected" in claim 1(c). This leads to a nonsensical situation: the Answer is asserting that the name read from the cookie in claim 1(c) is "selected" "based on" the name read from the cookie in claim 1(b).

Appellant submits that this simply makes no sense. The name cannot be "selected" "based on" itself.

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A third problem is another view of the second problem. In Javascript, the name read from the cookie is not "selected" "based on" any "background research," as required by the claim. Instead, in actual fact, the name in Javascript is read from a cookie which was selected because it contained a certain web site's name.

The web site's name in the cookie is the causative agent which causes the person's name in that cookie to be retrieved. That is the only condition for retrieving the name in Javascript. That condition is that the cookie contain the name of the web site being visited.

To repeat: when the proper cookie is found (that is, the one containing the web site's name), Javascript is programmed to read the "name field" and return the name (if present) as a string variable.

-- No "background research" need be present.
-- Therefore, the reading of the name field
in Javascript is not **"based on"** any
"background research."

Restated again: if no "background research" is done in Javascript, the name field in the cookie would **still be retrieved**. That shows that retrieving the name field is not "based on" any "background research," because no such "research" is required to retrieve the name.

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CONCLUSION

If the cookie-look-up in Javascript shows the claimed "background research," then claim 1(c) is absent from Javascript.

Claim 1(c) states that "second information" is "selected" "based on" the "background research."

-- The Answer treats the person's name in the cookie as the "second information." But that name is retrieved whether or not any "background research" is done. Thus, the "selection" is not "based on" any "background research." If no "background research" were done, the person's name would be retrieved anyway.

-- The Answer asserts that the person's name is selected, "based on" the person's name. Appellant submits that this makes no sense.

Claim 1(c) is not found in Javascript.

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ALTERNATE INTERPRETATION

As explained above, the Answer is using a **single event** in Javascript to show **two claim recitations**. That is not allowed.

It is possible that the Answer is dividing that **single event** into two sub-events. The Answer could be treating

-- the **initiation** of the search-for-the-cookie in Javascript as the "background research" of claim 1(b),

and

-- the **actual reading** of the name from the cookie, once found, as the "selecting" of "information" of claim 1(c).

However, this approach is fraught with problems.

One problem is that the mere **initiating** of supposed "background research" does not qualify as "**performing . . . background research**" as claimed.

One reason is that, in the present context, the only thing which the supposed "background research" can obtain in Javascript is the person's-name-in-the-cookie. If the "background research" is only **initiated**, but not completed, then the name is **never obtained**.

If the name is not obtained, then no "background research" is "performed." It is only "initiated," and the claim does not say

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that.

In essence, this approach re-writes claim 1(b) as stating "**initiating** first background research" rather than "**performing** first background research," as it actually does.

Re-writing claims is not allowed. Claims are analyzed as they are written.

A second problem is that, as explained above, the name of the visitor is not known when this supposed "background research" is initiated. Further, the "research" which is initiated is for a web site's cookie, based on the web site's name.

Thus, the mere **initiation** of a search for a cookie, named after something else (a web site), cannot qualify as "performing . . . background research on the . . . visitor."

-- The "research" is looking for a cookie named after a web site.

-- The name of the person is not known at that time of "initiation."

For example, how does initiation of a search for a cookie containing "WEB SITE A" qualify as "performing . . . background research" on a specific person, as claimed, who is not known ?

It does not.

A third problem is that claim 1(c) states that the "selecting"

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is "**based on**" the "background research." If the "background research" is merely **begun**, but not completed, and has procured no person's name, how can the later "selecting" be "based on" it ?

That is, how can "selecting" be "based on" the incomplete process of merely beginning "background research" ? The incomplete research has produced no **content** upon which to base the "selecting." How can "selecting" be "based upon" **nothing** ?

Appellant therefore submits that the splitting of the **single event** of Javascript into two sub-events is not valid, and still does not show claim 1.

ADDITIONAL POINT 1

A cookie-look-up in Javascript was used to show the "performing . . . background research" of claim 1(b).

However, Javascript asserts that this cookie-look-up serves to identify the visitor to the web site. The Answer agrees: on page 19, first paragraph, for example, it asserts that Javascript's cookie-look-up identifies a visitor.

Appellant points out this **discrepancy**:

- 1) On the one hand, both the Answer and Javascript state that the cookie-look-up identifies the visitor.
- 2) On the other hand, the Answer uses

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Javascript's cookie-look-up to show
"background research" of claim 1(b).

Therefore, the Answer is inconsistent in treating cookie-look-up as "background research." It is inconsistent with (1) Javascript, and (2) its other statements, both of which refer to the cookie-look-up as identification.

As a minimum, a definition of "background research" must be provided, so that it can be determined whether identification through a cookie-look-up qualifies as such.

MPEP § 2164.04 states:

For terms that . . . could have more than one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and **explicitly set forth the meaning of the term** and the scope of the claim when writing an Office action.

Stated more simply, the Answer is using **different terms** ("identification" and "background research") to describe a **single** event (name-retrieval from a cookie). That is not allowed until a definition is given for "background research."

ADDITIONAL POINT 2

The Answer states that, when the cookie is created,

- 1) the visitor identifies himself by name,

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and

2) that name is stored in the cookie.

The Answer then asserts that this shows the "identifying" of claim 1(a). (TABLE, page 13.)

However, when the same person visits the same web site at a later time, the Answer asserts that looking up the same cookie, and retrieving the name is not "identification," but is "background research."

Appellant submits that to be an unreasonable interpretation of the claim.

When the person visits the web site the second time, that person's identity is not known. Thus, the cookie-look-up is an attempt to identify the person. And Javascript and the Answer agree, as ADDITIONAL POINT 1, immediately above, indicates.

Restated, Appellant submits that the cookie-look-up on the second visit must be treated as "identification," not background research. Javascript treats it as identification, and the Answer agrees, as just explained.

ADDITIONAL POINT 3

Assume that, in Javascript, the visitor's name is Jack Wilson, and that name is stored in the cookie.

According to the TABLE on page 13 of the Answer, the name "Jack Wilson" is retrieved when claim 1(b) is applied to

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Javascript, and the **same name** "Jack Wilson" is retrieved when claim 1(c) is applied.

Appellant submits that this reading of the claim simply makes no sense. And the reason is that a **single event** (retrieving "Jack Wilson") is used to show **both** claim 1(b) and (c).

CONCLUSION

The Answer relies on a **single event** in Javascript to show **two claim elements**. That is not allowed.

The **single event** is the reading of a person's name from a cookie.

The TABLE in the Answer, page 13, describes that **single event** in two different ways, presumably to disguise the fact that a **single event** is being used twice.

Further, even if that event is allowed to be used twice, that event does not show both claim 1(b) and (c). That event is the reading of the person's name from the cookie. That reading cannot qualify as

- 1) the "background research" of claim 1(b)
and
- 2) the "selecting" of "first information"
"based on" the "background research" as in
claim 1(c).

In so doing, the Answer "selects" the person's name, "based

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on" the person's name. That makes no sense.

This Overview applies to all other independent claims, wherein the Answer also uses a **single** event in Javascript, to show two claim elements.

It is believed that this Overview is sufficient to justify allowance of all claims. This Overview shows that all independent claims are not shown in Javascript, and that justifies allowance of their dependent claims.

Thus, if the reader finds this Overview persuasive, then the rest of this Reply need not be considered. But the rest of this Reply is submitted for completeness.

COMMENT

Not all points made in this Overview are elaborated below. Some are considered self-explanatory.

END OVERVIEW

ANSWER, PAGES 3 - 12

This section of the Answer repeats matter set forth in prior Office Actions. Appellant's Brief addresses this matter.

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ANSWER, PAGE 13

Point 1

The TABLE on page 13 of the Answer has been addressed in the Overview, above.

In addition, Appellant points out the following.

Assume that the cookie in Javascript stores the name of visitor Jack Wilson.

Under the PTO's reading of claim 1(b) onto Javascript, the name "Jack Wilson" is retrieved, as "background research."

Under the PTO's reading of claim 1(c) onto Javascript, the name "Jack Wilson" is "selected," as the "first information."

There is no other information in the cookie which can be retrieved in this context. Only "Jack Wilson" can be retrieved.

Appellant respectfully submits that this reading of claim 1 makes no sense.

How does the name "Jack Wilson" qualify as both the

- 1) "background research" of claim 1(b)
and
2) the "first information" of claim 1(c) ?

Point 2

Appellant points out that claim 1(a) recites "identifying" a "first visitor." Javascript does not actually do that.

Javascript merely invites the visitor to state a name. It is

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well known that, under such circumstances, many people fabricate a "handle," such as BigMac, for that name. In such cases, there is clearly no "identification" of the person.

Point 3

The Office Action asserts that the cookie-look-up in Javascript shows the "background research" of claim 1(b). However, that is not actually so.

The cookie-look-up only retrieves the name provided by the person when the cookie was created. That does not necessarily indicate "background research" of the new visitor, who may be a different person.

ANSWER, PAGE 14, FIRST PARAGRAPH

This paragraph fails to fully rebut Appellant's assertion. At best, this paragraph only shows that "identifying" occurs when a visitor gives his name, which is then stored in a cookie.

That does not rebut Appellant's other arguments, regarding other types of claimed "identifying." For example, Appellant argued that, if a stranger uses a computer, and a web site looks up a cookie in that computer, the cookie will not identify the stranger.

The Answer's paragraph does not rebut that.

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ANSWER, PAGE 14, SECOND THROUGH FOURTH PARAGRAPHS

The PTO argues that the mere copying of information (such as retrieving a name from a cookie, and printing the name on a computer screen) qualifies as "identifying."

Appellant's analogies show such an argument to be false. The mere manipulation of a name does not amount to "identification."

The Answer, in essence, argues that computers possess capabilities which are different from those of the analogies. However, even if that be true, those capabilities, nor their implementation, have not been shown in the prior art, nor in Javascript.

Only prior art can be used to support the rejection, and those supposed capabilities of computers have not been shown in the prior art.

ANSWER, PARAGRAPH BRIDGING PAGES 14 and 15

This paragraph asserts that "it is the user who is identifying himself to the website, and not the cookie." However, this assertion, even if correct, is not dispositive.

The PTO's own Table, used to show claim 1 in Javascript, asserts that the name read from a cookie serves to identify the user.

Also, the paragraph contains a non sequitur.

The paragraph begins by pointing to Appellant's statement that

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the cookie does not necessarily identify a visitor to a web site correctly. In attempted rebuttal, the paragraph asserts that "it is the user who is identifying himself to the website, and not the cookie." But that rebuttal does not affect the fact that cookies can erroneously identify visitors to web sites.

ANSWER, PAGE 15, FIRST AND SECOND FULL PARAGRAPHS

Point 1

Appellant now agrees that if a web site orders (1) software on a computer to retrieve a name from a cookie and (2) the computer to display a screen containing that name, but without transmitting the name to the web site, those actions can qualify as a "method of operating a web site."

Point 2

Appellant points out that it is not relevant whether claim 1 states that the web site never obtains the name in the cookie. Appellant was simply pointing out a **fact** which makes it impossible for Javascript to show claim 1(d).

But the claim is not required to set forth that fact. The fact is self-existing.

If the Answer is asserting that the web site transmits the matter of claim 1(d), Appellant points out that the web site cannot do that. It never receives the name, in Javascript.

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Point 3

The Answer, second full paragraph, second-to-last sentence, asserts that two events occur in Javascript:

- 1) the user's name is located in a cookie,
and then
- 2) the user's name is "selected."

This is an incorrect description of what occurs in Javascript.

This description implies that the user's name is first "located," and then "selected." In fact, the following occurs: the web site's cookie is located. Inquiry is made whether a user's name is present therein. If so, it is retrieved and displayed to the user.

There is no "selection."

- If a user's name is present in the cookie,
it is displayed.
- If not, no display is done.

There is no "selection." No decision is made as to whether to display the name, or not.

ANSWER, PAGE 15, LAST PARAGRAPH

The Answer asserts that the user identifies himself to the website, and thus identification occurs.

Appellant merely argued that, if the web site causes a name

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from a cookie to be retrieved, that is not necessarily "identification."

The Answer's assertion does not rebut Appellant's statement. The Answer's assertion is not referring to cookie-retrieval, as is Appellant's statement. Instead, the Answer refers to the process wherein a person provides his name, which is then placed into a cookie.

ANSWER, PAGE 16, FIRST PARAGRAPH

The PTO's Table uses the **same element** in Javascript to show both claim 1(b) and (c). The PTO's table uses different words to describe that element.

But the element is the same in both cases, namely, obtaining a name from a cookie.

A **single** element in a reference cannot be used to show to claim recitations.

ANSWER, PAGE 16, SECOND PARAGRAPH

Point 1

Appellant points out that the Answer is simply correct.

In Javascript, a given computer will be given a cookie by a web site. That cookie may contain the name of a person.

EVERY PERSON who uses that computer, and who visits **THAT WEB SITE** will be greeted by that single name, which is in the cookie.

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Point 2

The Answer states, "Javascript teaches remembering the name of each individual user who visits the web site."

Javascript does not do that.

Assume that Dad visits a web site for the first time, and a cookie with Dad's name in it is placed into the computer. If Son later visits the same web site, using the same computer, no cookie will be added to the computer (unless the first cookie had been erased, and the web site detected that).

Javascript does not do what the Answer states. Javascript will not "remember" both Dad and Son.

ANSWER, PAGE 16, THIRD PARAGRAPH

The Brief, page 25 et seq., section entitled "Claimed 'Background Research' Clearly Absent from Javascript" rebuts this part of the Answer.

ANSWER, PAGE 16, LAST PARAGRAPH

The cookies are listed by name of the web site which created them.

When a user visits a web site, the web site's cookie is located based on the web site's name.

If John Q visits Web Site A, John Q's name may become placed

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in a cookie labeled Web Site A.

That cookie is stored in a computer. **Any person** then visiting Web Site A using that computer will be identified as "John Q."

The "research" is not done on John Q. Any supposed "research" is done on the computer storing the cookie, or on the collection of cookies in that computer, depending on your perspective.

As to perspective: is research done "on" (1) a person about whom information is sought, or (2) a collection of information containing data about the person, or (3) both (1) and (2) ?

Further, the TABLE on page 13 of the Answer does not assert that John Q is identified using cookies. It only states that he is identified (as in claim 1(a)) when he gives his name. That occurs when he first visits the web site.

ANSWER, PAGES 17, FIRST PARAGRAPH

Point 1

The Office Actions asserted that Javascript's cookies serve to identify visitors. The Brief explains why that is not necessarily true (a different person may use the same computer to visit the same web site). Thus, Appellant concludes that Javascript does not actually identify all visitors.

Javascript's activity may be an **attempt** to identify the visitor. But Javascript is not 100 percent accurate.

Claim 1(a) recites "identifying." There is no requirement

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that the claim state that the "identifying" is 100 percent effective.

-- If a process fails to identify the object in question, that process, at that time, neither infringes nor anticipates. It fails to "identify" as claimed.

-- Of course, that same process may, at other times, correctly perform identification. At those times, as an abstract concept, and subject to other rules, it is possible for the process to infringe or anticipate, or both.

Further, there is no requirement that the Specification show a process which is 100 percent accurate, so long as a process is shown in which "identification" is successful.

Point 2

The Answer is being inconsistent.

The TABLE, page 13, asserts that the identification of claim 1(a) occurs when a visitor to a web site gives his name. That name is stored in a cookie.

The TABLE never asserts that a later look-up of the cookie serves to identify the visitor.

And even if that look-up is used, which "identified" the visitor, then the Answer cannot use that look-up as also showing

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the "background research" of claim 1(b) and the "selection" of claim 1(c).

A **single event** in Javascript cannot be used to show multiple claim elements.

ANSWER, PAGE 17, SECOND PARAGRAPH

Javascript does not remember "the name of each individual user." The Dad/Son example above shows this.

Further, Javascript is not enabling to attain that. Assume a family of six persons, who use a single computer. If Javascript remembered the name of all six persons, what happens when Mother logs into a web site ? How does Javascript identify Mother ?

In addition, the Answer's assertion does not actually rebut Appellant's statement.

Appellant stated that Javascript does not necessarily "identify" every visitor correctly. In contrast to this, the Answer asserts that Javascript remembers every visitor. That is a different thing, and does not contradict Appellant's statement.

ANSWER, PARAGRAPH BRIDGING PAGES 17 AND 18

The Final Office Action asserted, in essence, that, if a researcher performs research, but the research is physically done "in the background" (eg, at a desk, located in the "background" on a stage in a theater), then the research clearly qualifies as

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"background research."

That is simply not correct. The claim refers to "background research" on the person claimed. It does not refer to the surroundings of the party performing the research.

Therefore, the assertion that Javascript operates in some "background," and thereby shows the claimed "background research" is clearly incorrect.

Further, numerous words have multiple different meanings. "Box" may mean (1) to engage in the art of fisticuffs or (2) enclose in a cardboard container.

Similarly, the term "background" may refer to (1) past events and characteristics of a person or (2) the physical surroundings in which something is done. Those are completely different definitions. And that is not Appellant's fault. Appellant has no control over the English language.

MPEP § 2173.05(a) states:

During patent examination, the pending claims must be given the broadest reasonable interpretation **consistent with the specification.**

MPEP § 2173.05(n) states:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or

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antecedent basis in the description so that the meaning of the terms may be ascertained by reference to the description.

At no place does the Specification refer to "background" in the sense of the surroundings in which the claimed "research" is done.

As to the very last sentence in this paragraph (top of page 18), it is ultimately a question of claim interpretation whether the following qualifies as "background research."

- Upon arrival of an anonymous person to a web site,
- Looking up a cookie,
- Locating a name of a person in the cookie, and
- When the name is not necessarily the name of the anonymous person,

ANSWER, PAGE 18, FIRST FULL PARAGRAPH

No reply needed.

ANSWER, PAGE 18, SECOND FULL PARAGRAPH

Claim 5 recites:

5. A method of operating a web site, comprising:
 - a) receiving an inquiry from a visitor to the

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web site;

- b) estimating whether the visitor possesses selected characteristics;
- c) based on the estimate, selecting first information from a collection of information;
- d) in response to the inquiry, selecting second information; and
- e) compiling the first and second information into a message, and transmitting the message to the visitor.

Even assuming arguendo that the PTO's application of claim 5 to Javascript is correct, claim 5(e) has not been shown.

The "message" of claim 5(e) contains two parts, namely, the "first information" and the "second information."

- The "first information" was "selected" "based on the estimate."
- The "second information" was "selected" "in response to the inquiry."

The PTO has not shown that in Javascript.

Instead, the PTO asserts that "frames" which are displayed in Javascript correspond to the "first" and "second" "information." That is simply not so.

"Frames" appear to be mini-windows, or "panes" in a window. That is, a window can contain, for example, four documents, each in its own "frame."

But the claimed "selection" of each "frame" (ie, "based on

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the estimate" and "in response to the inquiry") has not been shown in Javascript. As a minimum, those "selected" "frames" must be "compiled" into a "message," and transmitted, as in paragraph (e). That has not been shown.

Also, the Office Action has not identified the "inquiry" of claim 5(a). Appellant, in his previous Amendment, requested that the "inquiry" be identified. To date, no identification has been made.

ANSWER, PAGE 18, THIRD FULL PARAGRAPH

The Answer mis-apprehends the Brief.

The Answer states that the Brief argues that Javascript does not disclose manner of display at all, and then continues to attempt to rebut the Brief.

The Brief never said that.

The Brief simply pointed out that

1) the Final Action pointed to certain subject matter of Javascript as showing claim 6,

but

2) that subject matter does not correspond to, nor is it recited in, claim 6.

The Brief summarized this by stating that

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Javascript states that when a web page is visited, the web page is displayed according to certain stated preferences.

However, claim 6 does not recite that. One reason is that claim 6 does not discuss **manner-of-display** at all.

(Brief, page 35.)

Further, the Answer merely asserts that "first and second" information is displayed to the user. Claim 6 recites more than that, and the additional recitations have not been shown in Javascript.

ANSWER, PAGE 18, LAST FULL PARAGRAPH

No reply needed.

ANSWER, PAGE 19, FIRST FULL PARAGRAPH

The Brief, page 36, section entitled "Point 1" rebuts the Answer.

Part of that section is repeated here:

Claim 10(b) states that the "identity" of the visitor is ascertained. Claim 10(c) states that "visitor-specific information" is derived **"based on** the identity."

As explained above, that is not found in Javascript.

The Office Action asserts that the cookie in Javascript contains user-preferences, which the Office Action asserts to be the claimed "visitor-specific information."

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However, that "visitor-specific information" is not located "based on" the "identity" of the visitor. It is located "based on" the Internet address in the cookie.

That is, the web site orders the cookie to be found. The cookie is found based on the web site's Internet address, which is contained in the cookie. Once found, the cookie provides both (1) the name of a person and (2) the supposed "visitor-specific information."

The latter (the "visitor-specific information") is not found "based on" the former (the name). Instead, they are **both found together**, using the web site's Internet address.

ANSWER, PAGE 19, SECOND FULL PARAGRAPH

Point 1

Appellant submits that no significant difference exists between the exemplary message proposed by Appellant, and that proposed by the PTO.

In either case, Appellant repeats his questions of page 39 of the Brief:

- Why would the user wish to receive a message telling him of his preferences ?
- And where does Javascript discuss this ?

Appellant submits that, until these questions are answered, the PTO cannot assume that either proposed message is present

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Point 2

The PTO agrees that the basic content of its "message" would indicate how the user prefers to view material presented on a computer screen. (Blue background, 12-point font, etc.) However, that does not correspond to the claimed "user-specific information."

Claim 10 states that the "user-specific information" is derived "based on the identity" of the person.

In Javascript, the user-preferences are obtained from a cookie. The cookie is located based on the name of the web site.

Thus, the user-preferences are derived based on the **name of the web site**, not based on the identity of the person.

The cookie may, or may not, contain the name of a person. If it does not, then clearly, no "user-preferences" can be derived "based on" the identity of the (non-existent) person.

If the cookie **does** contain a name, that is simply incidental. The "user-preferences" are not derived "based on" the name. One reason is that, as just explained, the name need not be present.

Another reason is that the person can (presumably) change the name. Does that change the user-preferences ?

No, the name is just one piece of data, which is present along with other data in the cookie. If the PTO's reasoning be accepted, then the mere presence of **anything** in the cookie means that the "user-preferences" are "derived" based on those other things.

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That is clearly incorrect.

Here is the situation. The cookie supposedly contains data, such as (1) a person's name, (2) the user-preferences, (3) the name of the web site, etc.

Javascript uses the name of the web site (when the web site is visited) to locate the cookie, and then supposedly generates the message containing the user-preferences. But the user-preferences are **not derived based on the person's name**, as claimed.

ANSWER, PAGE 20, FIRST FULL PARAGRAPH

Point 1

The Answer is apparently responding to the section headed "Point 4" in the Brief, page 39. That section began by asserting that the PTO is treating the "targeting" of Javascript as the claimed "inquiry" in claim 10.¹ That section of the Brief then showed why that is not so.

To shorten a long story: if that **were** so, then when a visitor requested a catalog page by number, and a web site returned that page, the web site would "derive" that page.

But returning a requested page does not amount to "deriving"

¹ The Answer asserts that Appellant states that the "targeting" "is the inquiry . . . in claim 10." That is not correct. Appellant did not admit that.

Appellant simply pointed out that the PTO (not Appellant) is **asserting** that the "targeting" is the "inquiry."

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the page.

Point 2

But independent of the preceding, the Answer now asserts that the PTO is **NOT** making the assertion in question (that "targeting" is the "inquiry.")

The Answer now asserts that

-- a request for a web page is the claimed
"inquiry"

and

-- "in response to the loading of the web page, the personalized information is retrieved or derived, put together and sent to the user's browser for display."

Appellant responds by repeating part of the Brief:

Claim 10(e) states that the "derived" "response information" is placed into a "message," which is transmitted to the visitor.

That "message" has not been shown in Javascript.

Further still, claim 10(e) states that this "message" also contains the "visitor-specific information." That has not been shown in Javascript either.

(Brief, page 40.)

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ANSWER, PAGE 20, SECOND FULL PARAGRAPH

Point 1

Appellant points out that the PTO asserts that, for a visitor to a web site, Javascript retrieves the (1) visitor's name, and (2) visitor's preferences, from a cookie.

That may be so.

The PTO then asserts that those two items are sent to a web page. The PTO does not state this explicitly, but does state that the web page "containing the name and the preferences is . . . sent back [to the visitor]." Thus, the two items (name and preferences) must have been sent to the web page, in order for the web page to send them back.

That is impossible.

As previously explained, in Javascript, the cookie is located at the visitor's own computer, that is, on the desk in front of the visitor. As also explained, Javascript states that no cookie-information is sent to the web site.

Therefore, the web site cannot obtain these two items of information. The third sentence of the Answer ("A web page . . . page 178)" is factually incorrect.

This conclusion makes sense. The "preferences" relied on by the PTO are supposedly stored in a cookie, and are used to determine how information is displayed to the user. The user's computer needs to know those preferences, not the web site.

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Why would the "preferences" be sent to the web site ?

Point 2

The interpretation of claims 10 and 11 is inconsistent with the interpretation of claim 1.

Claim 10(b) recites "b) ascertaining identity of the visitor." The PTO relies on locating the visitor's name in a cookie to show this.

Claim 1(a) recites "a) identifying a first visitor to the web site." To show this, the PTO relies on a previous visit to the web site, wherein the person identified himself.

Those interpretations are inconsistent.

ANSWER, PARAGRAPH BRIDGING PAGES 20 AND 21

Point 1

The Answer asserts that a visitor's name, read from a cookie, is transmitted to a web site. The web site then supposedly creates a web page, which contains the name just received, and the web page is then transmitted back to the visitor.

The problem with this assertion is that Javascript expressly states that no cookie-information is sent to the web site. (See the second "Q" in the Q&A section of Javascript.) Thus, the Answer's proposed operation of Javascript is not present.

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Point 2

The Answer states that "the first information" of claim 1 is the web page described in Point 1, above.

That is not possible.

Claim 1 recites:

...

b) performing first background research on the first visitor;

c) based on the background research, selecting first information from a collection of information; and

d) transmitting the first information to the first visitor.

Appellant asks:

-- If the "first information" is a web page, then how is it "selected" "based on the background research," as claimed ? That is, the visitor "selected" the web page, when he visited the web site, correct ? How is that "selection" "based on" "background research" ?

-- According to the PTO, that "background research" is found in locating a visitor's name in a cookie. Then, under the claim language, the "first information" is

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"selected" "based on" that background research."

That would mean that, when the visitor visits a web page, thereby triggering the events of claim 1, a specific web page is selected, and presented, to the person.

That has never been shown in the references.

Further, that makes no sense. The person visits the web page of the claim. What is the reason for generating another web page (ie, the supposed "first information") in Javascript ? Why would Javascript replace a web page desired by the visitor by another web page ?

And does this process continue ad infinitum ? Is the new web page treated like the first web page, causing new "background research," etc. ?

-- Stated more simply, the PTO is asserting that Javascript locates a person's name in a cookie, and then selects a web page for that person. That has never been shown in the

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references.

ANSWER, PAGE 21, FIRST FULL PARAGRAPH

Claim 15 is of concern here, which depends from claims 1 and 2. These claims are set forth, for the convenience of the reader.

1. A method of operating a web site, comprising:

- a) identifying a first visitor to the web site;
- b) performing first background research on the first visitor;
- c) based on the background research, selecting first information from a collection of information; and
- d) transmitting the first information to the first visitor.

2. Method according to claim 1, and further comprising:

- e) identifying a second visitor to the web site;
- f) performing second background research on the second visitor;
- g) based on the second background research, selecting, from the collection of information, second information which is different from the first information; and
- h) transmitting the second information to the second visitor.

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15. Method according to claim 2, wherein the second information is made visible to the second visitor.

The rejection of claim 2 treated the recitation of "first information" (or "second information") as the name read from a cookie.

The rejection of claim 15 treated that recitation as a "web page, having multiple frames."

That is a contradiction. Both claims cannot be rejected under that interpretation.

The Answer attempts to resolve the contradiction by asserting that the "web page, having multiple frames" contains the name. That is, the "information" in question is supposedly the web page, which contains the name.

Appellant points out that this attempt fails to resolve the contradiction, and introduces new problems.

Problem 1

Under the claims, the "information" is "selected" "based on background research."

According to the Answer, the "background research" is found in locating a name in a cookie.

Thus, according to the Answer, the "information" is "selected" "based on" the name in the cookie.

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Appellant submits that it makes no sense for the Answer to now assert that the web page in Javascript corresponds to the "information." Where, in Javascript, is a web page "selected," based on a name found in a cookie ?

Problem 2

The Answer asserts that a web page is created, **which contains the name**, and is sent back to the user.

However, as explained above, Javascript states that no cookie-information is sent to the web site.

Therefore, the Answer's mode of operation is not possible.

ANSWER, PAGE 21, SECOND FULL PARAGRAPH

Claim 13 is in question.

Point 1

The Specification states that a visitor to a web site can be given (1) generic information, which is given to all visitors, and also (2) information specific to that visitor. (See Summary of Invention, for example.)

Consistent with the Specification, claim 13(c) recites "customer-specific information," and claim 13(d) recites "second information." Both are delivered in claim 13(e).

The Answer treats a **single element** of the Nehab reference as

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both types of information. That is not allowed. That **single element** is in Nehab's column 10, lines 21 - 36. That **single element** merely states that Nehab's "system will retrieve articles from Web sites which are listed in [the user's] personal news profile."

Where are the (1) "customer-specific information," and (2) "second information" ? They are not both present.

Point 2

The claim states that

-- the "customer-specific information" is derived in response to an expressed desire by the customer (claim 13(c)),
and

-- the "second information" is generated in response to the "inquiry" (claim 13(d)).

The **two different events** which induce the **two different types of information** have not been shown in Nehab.

Point 3

Claim 13(b) recites making an "estimate of selected characteristics of the visitor." Claim 13(c) states that the "customer-specific information" is derived based on that "estimate."

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However, as the Brief explains, there is no "estimate" in Nehab. (Brief, page 46, "REASON 3.") Thus, no "derivation" as in claim 13(c) can be "based on" the (absent) "estimate."

Also, Nehab chooses the articles to deliver to the customer, based on an "extraction rule." (Brief, page 45, "REASON 1.") The **customer**, not the web site, establishes that rule. Thus, even if the articles delivered qualify as "customer-specific information," they are not "selected" as recited in claim 13(c).

Therefore, the Answer is using a **single element** in Nehab to show the **two** types of information claimed. That is not allowed.

Further, the claim recites **two** elements: (1) "inquiry" of claim 13(a) and (2) expressed desire of claim 13(c). Those induce, or prompt, delivery of the **two** types of information. That has not been shown in Nehab.

ANSWER, PARAGRAPH BRIDGING PAGES 21 AND 22

Point 1

The Brief, page 45, states, "The claim states that the **web site** makes the estimate of 'selected characteristics'."

The Brief then points out that, in Nehab, the **user**, not the web site, sets the supposed "selected characteristics."

Thus, the Brief concludes, that claim recitation is not found in Nehab.

The Answer asserts that the claim does not recite that the web

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site makes the estimate in question. The Answer asserts that anybody can make the estimate.

In response, Appellant points out that the language of the claim (preamble plus paragraph (b)) requires that the "estimate" be made in a step which is "comprised" of "a method of operating a web site."

From a simpler point of view, some party, or parties, "operate" the web site. The "estimate" must be made by them, namely, the party/parties "operating" the web site.

"Operating" the web site clearly means "providing" and "maintaining" the web site. It does not mean "using" the web site.

"Operating" a web site is a term-of-art.

Nehab's customer, or visitor to the web site, does not "operate" the web site. He cannot (legally) shut down the web site, nor start it up, nor determine how it interacts with visitors.

Therefore, the customer's actions in Nehab are not "comprised" of "a method of operating a web site" as claimed.

The customer's establishment of the "extraction rule" does not correspond to the "estimate" of claim 13(b).

Point 2

The Answer, end of paragraph in question, states:

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According to the claim language, this could be **performed** by someone, or some component in another server or on behalf of the website.

(Please note **highlighted** term.)

At least two problems exist in this statement.

One problem is that no such person/component making the claimed "estimate" has been shown in Nehab. Until that is done, the Answer's statement is moot.

A second problem is that the statement is incorrect. As explained above, what is "performed" must qualify as "comprised" of "operating a web site." Stated more simply, "operating a web site" must "comprise" the "performance." That does not mean that anybody in the universe can do the "performance."

ANSWER, PAGE 22, FIRST FULL PARAGRAPH

The Answer cites Nehab, column 8, lines 38 - 67, as showing the "estimate" of "characteristics of the visitor" as in claim 13 (b) .

Point 1

Part of that passage (lines 38 - 44) states that, when a user visits a web site, the navigation steps (eg, mouse clicks) are memorized. Later, those steps are repeated.

That is not the claimed "estimate."

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Point 2

Another part of that passage (lines 45 - 50) states that, if a user "accesses **all articles** under a particular index/heading," then all articles under that heading will be retrieved later.

That is not an "estimate."

Point 3

Another part of that passage (lines 51 - 60), in essence, states that the user can specify Boolean key-word searches.

That is not an "estimate."

Appellant points out that this section of the passage sets forth five exemplary types of key-word searches. But the **customer** specifies all five, not Nehab's system.

Point 4

Another part of that passage (lines 61 - 67) points to a Figure, and gives examples of the rules just described.

That is not an "estimate."

Conclusion

In Nehab, the cited criteria for retrieving articles (ie, the supposed "customer-specific information") are **NOT** specified by Nehab's system, nor are they "estimates" "of selected

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characteristics of the visitor."

Instead, they are specific rules, not estimates, and they are generated by the customer, not Nehab's system.

Further, they do not indicate "characteristics of the visitor."

ANSWER, PAGE 22, SECOND FULL PARAGRAPH

Point 1

The Answer cites Nehab, column 10, lines 21 - 36, to show claim 13(c). Appellant repeats a passage from the Brief:

However, that passage does not ask the user "whether" anything is desired, but **when** "delivery time" is desired. At that desired delivery time, Nehab's system searches the Internet for the material meeting the criteria discussed above, and delivers it.

That is not asking "whether" the user desires "customer-specific information."

(Brief, page 47.)

Appellant points out that Nehab's asking of **when** delivery is desired has an **infinite** number of possible answers: one minute from now, two minutes, etc.

The claim's asking of **whether** delivery is desired has **two** possible answers: Yes or No.

Point 2

The claimed **response** to the question is different from Nehab's response.

-- The claim's response to an **affirmative answer**: "deriving customer-specific information **based on the estimate.**" In Nehab, there is no "estimate," nor is any "deriving" "based on the estimate."

-- Instead, in Nehab, **specific, identified** "news articles" are delivered, at set times. Thus, the response is **different** than the claimed response. And there is no affirmative answer, only a specification of desired times of delivery.

In addition, the claim recites a second response (to a **negative answer**), which is not found in Nehab, and that second response is in claim 13(e).

Therefore, under the claim,

-- If the customer's answer to claim 13(c) is **negative**, the customer only gets the "second information."

-- If the customer's answer is **affirmative**, the customer gets **both** the "customer-specific

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information" and the "second information."

These two alternate deliveries are not found in Nehab.

ANSWER, PARAGRAPH BRIDGING PAGES 22 AND 23

The Brief asserted that claim 13(e) is not found in Nehab, because the two **types** of information as claimed are not combined into a single message.

The Answer asserts that, since Nehab packages **multiple** news articles into the supposed "message," then the two **types** of information are present.

However, several problems exist in this assertion.

Problem 1

Only a **single** type of information is present in Nehab, namely, news articles.

Problem 2

That **single** type of information lacks the two inducing, or prompting, agencies of the claim.

-- The claim states that the "second information" is induced by the "inquiry."

-- The claim states that the "customer-specific information" is induced by the answer to the "asking" of claim 13(c).

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Those two inducing, or prompting, agencies are not found in Nehab. Nor are the two **different** types of information present in Nehab.

Problem 3

As explained above, in claim 13(e), the "customer-specific information" may not be delivered, because the customer may have said No in claim 13(c). But the "second information" is still delivered.

However, if Nehab sets no time for delivery (column 10, lines 34 - 36), there is no delivery at all.

Thus, the overall operation of the claim is not shown. That overall operation includes

- sending both types of information, if the answer in claim 13(c) is Yes,
- and
- sending only "second information" if the answer is No.

Problem 4

The Answer relies on two passages in Nehab to show the claim recitation. (Column 10, lines 30 - 44; column 11, line 60 - column 12, line 37.)

However, both passages merely state that news articles are

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retrieved from the Internet, based on the rules set up by the customer.

That does not show the two **types** of information recited, nor the alternate modes of delivery (both delivered, or only "second information" delivered.)

ANSWER, PAGE 23, FIRST FULL PARAGRAPH

The Brief sufficiently addresses the Answer. In short: claim 3 states that the "background research comprises contacting another web site."

Further, the claim depends from claim 1. In claim 1(b), the "background research" was found by the PTO in a cookie-look-up. Appellant points out that this cookie-look-up, in Javascript, occurs in the computer being used by the web site visitor.

Appellant fails to see, and the PTO has not explained, how that cookie-look-up can "comprise contacting another web site" as claimed.

ANSWER, PAGE 23, SECOND FULL PARAGRAPH

Point 1

Claim 1 recites a "method." That "method" includes "performing background research," according to claim 1(b). Under the Preamble, that "method" is "a method of operating a web site."

Claim 3 states that the "background research comprises

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contacting another web site."

Therefore, the "method of operating a web site" includes "performing background research" which "background research comprises contacting another web site."

The Answer has not shown a "method of operating a web site" in the references which does that.

Point 2

The claim is not required to state who, or what, does the method.

The questions are

- 1) are the steps, or processes (eg, claim 1(b), 1(c), etc.), present in the references, and
- 2) are those steps/processes includes in a "method of operating a web site" ?

The Answer has not shown that the "contacting" in question is done by a web site. So it is reasonable to conclude that the "contacting" is **NOT** done in a "method of operating a web site," as required.

ANSWER, PARAGRAPH BRIDGING PAGES 23 AND 24

Background

Claim 1(b) recites "background research." The PTO finds that

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in a cookie-look-up in Javascript.

Dependent claim 3 states that the "background research comprises contacting another web site." Nehab compiles a list of web sites which a person visited. The PTO now asserts (contrary to the rejection of claim 1) that this list of web sites qualifies as the "background research."

Appellant, in the Brief (page 50, POINT 3), asked **HOW** the name from the cookie-look-up (ie, the supposed "background research" of claim 1(b)) now gets placed into Nehab's list of web sites. It must be placed there because it must be available for retrieval.

Answer's Response

Appellant respectfully submits that the Answer must contain typographical errors, because the Answer's response makes no logical sense.

The Answer first states that Javascript obtains the user's name from a cookie.

The Answer then states that Nehab retrieves news articles for a user.²

The Answer concludes that it is "obvious" to include a web page which contains (1) the user's name and (2) the news articles.

² The Answer actually asserts that Nehab "retrieve[s] articles based upon an estimation of user's tastes." As this Reply indicates, Appellant disputes that entire statement.

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However, several problems are present in this conclusion.

Problem 1

One problem is that the conclusion refers to a "web page" which includes the two stated items (name and articles). However, that "web page" has never been shown in the references.

Problem 2

A second problem is that the conclusion does not follow, as a matter of logic, from the two premises, that is, the two descriptions of the two references. That is, the facts that (1) Javascript looks up a name in a cookie and (2) Nehab retrieves news articles simply do not lead to the conclusion that a web page should be created containing those two facts.

This problem is further illustrated by the fact that web pages are **available to the public**. Why would such information be placed into a web page, and who in the public would be interested ?

Problem 3

A third problem is that the Answer asserts that it is "obvious" to create such a web page.

However, the (hypothetical) web page in question was created in response to Appellant's question in the Brief. That question asked how (1) the name from Javascript's cookie-look-up would be

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added to (2) Nehab's list of news articles, so that the name would be available (since the name is supposedly the "background research").

The answer to Appellant's question is that the addition of those two elements (name and list) is "obvious."

The difficulty here is that only "inventions" can be obvious.

Further, the Answer's response does not answer Appellant's question.

Additional Point

The Answer's response now raises a new question.

Parent claim 1(d) states:

c) based on the background research, selecting first information from a collection of information.

Now, according to the Answer, the "background research" contains the new web site, which contains (1) Javascript's name-from-a-cookie and (2) Nehab's list of articles.

How can "first information" be "selected" "from a collection of information" **based on** that new web site, as recited in claim 1(c) ?

Appellant submits that no answer is possible. Certainly, no answer suggests itself.

Therefore, no reasonable expectation of success has been

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shown, as required by MPEP § 706.02(j), which states:

Contents of a 35 U.S.C. 103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met.

Second, there must be a reasonable expectation of success.

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

How do you "select" "information" "based on" a web site which contains (1) a person's name and (2) Nehab's list of news articles ?

ANSWER, PAGE 24, FIRST FULL PARAGRAPH

Point 1

The Answer's response now is inconsistent with its previous interpretation of Nehab.

Claim 4, in context, presumes that **two** persons are involved, and that **two** background researches are performed. Claim 4 states that a **single** web site may be contacted in **both** researches. For example, a **single** credit agency can be contacted for **both** persons.

To show this, the Answer relies on the fact that Nehab may

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contact the same web sites, to retrieve news articles, at two different times.

However, the problem is that Nehab is not performing the claimed "background researches" at that time. He is retrieving the "first information" or the "second information."

As the Brief points out (page 50, "POINT 3"), the Answer interprets the "background research" of the parent claim as Javascript's looking up a name in a cookie.

Now, the Answer interprets the "background research" as retrieving the "first/second" "information" from the Internet.

That inconsistent interpretation is not allowed.

The "background research" of a dependent claim must be the same as that in the parent claim.

Point 2

The last sentence of the paragraph in the Answer sets forth a rationale for combining the references. The rationale is that the combination provides "personalized experience containing relevant information."

However, Nehab, **by himself**, provides that "personalized experience." There is no reason to add Javascript.

Restated, if the goal is to obtain the "personalized experience," you only need the Nehab reference. There is no logical reason to add Javascript.

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Further, the Answer has not explained how Javascript adds anything to the "personal experience" of Nehab.

In addition, the rationale merely sets forth a supposed characteristic of the references, **once combined**. That is not a teaching for making the combination in the first place.

Further, MPEP § 706.02(j) states that the rationale for combining references must be found in the prior art. The Answer has not shown the rationale of seeking "personal experience" in the prior art.

That MPEP section states:

Contents of a 35 U.S.C. 103 Rejection

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

ANSWER, PAGE 24, LAST PARAGRAPH

Point 1

The Answer has now changed the rationale for combining references. However, the new rationale is defective.

The new rationale is based on the erroneous assertion that Landan sends an e-mail message containing "personalized information thought to be needed by the user."

In fact, that message notifies system administrators of problems in web sites. (See Brief, page 54, "Point 1.") There is nothing "personal" at all in such a message.

This is proven by the fact that, in a system which operates 16 hours per day, seven days a week, several administrators will

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be present, though at different times.

There is no reason to believe that Landan's message will be different for Administrator A, compared with Administrator B.

Point 2

No showing has been made that Landan states that the message is "personal."

Point 3

The last sentence of the paragraph invokes a principle that is completely irrelevant to the references, to justify combining them.

The principle is that the combination of references produces "personalized experience."

However, no discussion of "personal experience" has been shown in either reference.

Further, the Answer (incorrectly) asserts that Landan provides "personal information" in his e-mail message. Thus, by the Answer's own reasoning, if "personalized experience" is desired, then Landan, by himself, provides it. There is no reason to add Javascript.

GENERAL POINT REGARDING LAST THREE PARAGRAPHS OF ANSWER

"Personalized experience" is an utterly vague term. It can

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be said that any time a "person" is involved, then "personalized experience" is obtained.

Without a precise definition of "personalized experience," that term cannot be used as a motivation for combining references. One reason is that, without a definition, no determination can be made as to whether the combination of references actually **provides** "personalized experience."

CONCLUSION

Appellant requests that the Board overturn all rejections, and pass all claims to issue.

Respectfully submitted,



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